

REMARKS

This is in response to the Office Action dated January 16, 2007. Claims 1-27 and 31-33 are pending and rejected, as set forth below.

In the Office action, the Examiner allowed claims 28-30. Applicant graciously thanks the Examiner for so concluding. Applicant respectfully submits that the claims as previously filed are in condition for allowance and respectfully requests reconsideration and further examination in view of the following.

Rejections under 35 U.S.C. §102(b)

Claims 1, 4-12, 15-25, 27, 32, and 33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent No. 5,078,723 to *Dance et al.* (*Dance*). At least for the reasons discussed below, applicant respectfully submits that the claims as originally filed patentably distinguish over *Dance*.

Independent claim 1 recites:

A device for removing a tubular body member from a body, the device comprising a cutting tool that includes:

- (a) a cutting head having
 - (i) a leading edge comprising an annular cutting blade, and
 - (ii) an attachment section; and
- (b) a body section having a proximal end, a distal end and an inner passage extending therethrough, the distal end operable to couple to the attachment section of the cutting head.

The cited art does not teach or suggest the features of independent claim 1. In particular, the cited art does not teach or suggest the features of a cutting head having an attachment section and a body section having a distal end operable to couple to the attachment section of the cutting head.

The Office Action contends that Dance discloses a cutting device comprising an attachment section as well as a distal end that is operable to couple to the attachment section of the cutting head. However, the Office Action fails to cite any passage or figure in *Dance* that teaches these features. The only reference to the construction of the device in *Dance* discloses that a “[c]utter head 56 is preferably brazed to ribbon 53” (Col. 3, lines 55-56). The Office Action states only in its “Response to Applicant Remarks” that Figure 4 of *Dance* “shows a cutting head 56 attached to a body section 53 having a distal end that couples to the cutting head.” Respectfully, however, nowhere in Figure 4 (or anywhere else in *Dance*) is there disclosed a cutting head having an attachment section and a body section having a distal end operable to couple to the attachment section of the cutting head.

In order for a reference to anticipate a claimed invention, the reference must identically disclose *each and every limitation*. Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193 at 198 (Fed. Cir 1983) (emphasis added). Here, *Dance* simply does not disclose or suggest the limitation of an “attachment section” as recited in claim 1, and neither of the two citations offered by the Office Action can be reasonably seen to teach this limitation. Since *Dance* does not disclose each and every limitation of claim 1, it cannot anticipate claim 1. Likewise, since independent claim 31 recites an attachment structure for attaching to a body section and independent claim 32 recites a body section connectable to the cutter head, *Dance* cannot anticipate claims 31 and 32 either. Accordingly, independent claims 1, 31, and 32 are believed

to be allowable over *Dance* and Applicants respectfully request reconsideration and withdrawal of the §102(b) rejections.

Independent claim 20 recites:

An apparatus for harvesting a tubular body member, the apparatus comprising:

(a) an endovascular component having a diameter smaller than the diameter of the tubular body member, the endovascular component capable of being inserted into the tubular body member;

(b) a cutting tool comprising:

- (i) a tubular body section;
- (ii) a cutting head attached to the tubular body section, the cutting head having a leading edge comprising an annular cutting blade; and
- (iii) an opening extending through the cutting tool;

wherein the opening is sized to allow the tubular body member and some body tissue surrounding the tubular body member to fit inside.

The cited art does not teach or suggest the features of independent claim 20. In particular, the cited art does not teach or suggest the feature of an opening extending through the cutting tool, wherein the opening is sized to allow the tubular body member and some body tissue surrounding the tubular body member to fit inside.

In its rejection of claim 20, the Office Action completely omits discussion of this feature. Moreover, it is clear from Figures 5-7 of *Dance* that the device in *Dance* fits wholly within a blood vessel, such as an artery. As such, the opening of the cutting tool disclosed in *Dance*

cannot be sized to allow the tubular body member and some body tissue surrounding the tubular body member to fit inside. The entire device disclosed in *Dance*, let alone an opening extending through a cutting tool, is smaller than the tubular body member itself. Since *Dance* does not disclose each and every limitation of claim 20, applicants respectfully submit claim 20 is allowable over *Dance*.

The remaining claims in the application are each dependent from one of the aforementioned independent claims and are believed to be allowable for the same reasons.

Rejections under 35 U.S.C. §103(a)

Claims 13 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,078,723 (*Dance*). Claims 5 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,078,723 (*Dance*) in view of U.S. Patent No. 5,551,443 (*Sepetka et al.*). Claims 2, 26 and 31 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,078,723 (*Dance*) in view of U.S. Patent No. 4,653,496 (*Bundy et al.*). Claims 3 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,078,723 (*Dance*) in view of U.S. Patent No. 5,084,010 (*Plaia et al.*).

As discussed above, *Dance* fails to disclose or suggest all the limitations of any independent claim upon which the claims rejected under 35 U.S.C. §103(a) depend. Furthermore, none of the additional references are seen to supply what is missing from *Dance*. Additionally, *Dance* actively teaches away from implementing the features of the rejected claims, and implementing such features would render the device of *Dance* unsatisfactory for its intended purpose.

A reference that teaches away from a particular combination or modification rebuts a prima facie showing of obviousness. In re Geisler, 116 F.3d 1465, 1471 (Fed. Cir. 1997).

Additionally, if a proposed modification would render the invention disclosed in a cited reference unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the modification. In re Gordon, 733 F.2d 900 (Fed. Cir. 1984). In this case, *Dance* discloses a device for removing stenosis (i.e.- tissue growth) from within arteries. See Abstract of *Dance*. To achieve this purpose, *Dance* discloses a device that fits wholly within a blood vessel to cut away the stenosis tissue formed within the blood vessel. *Dance* at Col. 1, lines 60-62; and Col. 2, lines 41-52. As such, *Dance* actively teaches away from the proposed modifications and combinations proposed by the Office Action, i.e. - to enable the device in *Dance* to remove a tubular body member from a body. Moreover, to implement the proposed modifications and combinations to the device in *Dance* to remove a tubular body member from a body, i.e.- the blood vessel itself, would clearly render the device unsatisfactory for its intended purpose.

For the reasons stated above, Applicants respectfully request the reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a).

CONCLUSION

Reconsideration is respectfully requested. Applicant believes the case is in condition for allowance and respectfully requests withdrawal of the rejections and allowance of the pending claims.

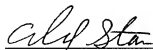
Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to **Deposit Account No. 19-3878**.

The Examiner is invited to telephone the undersigned at the telephone number listed below if it would in any way advance prosecution of this case.

Respectfully submitted,

Date: _____

4/12/07



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